

PATENT**D. REMARKS****Status of the Claims**

Claims 1-20 are currently present in the Application, and claims 1, 8, and 14 are independent claims. Claims 1-8, 11, 14, and 17 have been amended. Support for the amendments is found, for example, in Applicants' specification on page 16, line 27 through page 17, line 20 (also see Figure 1, reference numerals 150 and 190). Support for the amendments is further found, for example, on page 21, line 4 through page 22, line 11 (also see Figure 3, reference numeral 300), on page 26, lines 3-12, and on page 28, lines 5-13.

Examiner Interview

Applicants wish to thank the Examiner for the courtesy extended to Applicants' attorney during a telephone interview on Thursday, October 6. During the interview, Applicants' attorney explained that planning factor data, as claimed by Applicants, includes more than just compensation planning data. Paizis appears to be almost exclusively concerned with compensation (as discussed in detail below), and does not cover planning factor data that includes risk planning data. No agreement was reached regarding the claims.

Drawings

Applicants note with appreciation the Examiner's acceptance of Applicants' formal drawings, filed with the Application on June 29, 2001.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-7 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejections under 35 U.S.C. § 101.

Docket No. AUS920010233US1

Page 10 of 15

Atty Ref. No. 1027

Calderaro, et. al. - 09/895,893

PATENT

The Examiner states that claims 1-7 do not "apply, involve, use, or advance the technological arts" (see Office Action, page 2, line 22 through page 3, line 3). Applicants respectfully disagree, however, in the interest of advancing prosecution of the present Application, Applicants have amended claims 1-7. As amended, claims 1-7 claim "**a computer-implemented method** for managing personnel planning factors." Applicants have further amended independent claim 1 to clarify that the planning factor data is received "over a computer network," and that both the planning factor data and the actual employment data is stored in an "employee database." As noted above, support for these amendments is found in Applicants' specification on page 16, line 27 through page 17, line 20 (also see Figure 1, reference numerals 150 and 190). Thus, amended claims 1-7 clearly apply, involve, and use the technological arts in order to advance the technological arts. In other words, claims 1-7 claim a computer-implemented method that clearly uses a computer network and a database (as depicted in Figure 1 of Applicants' specification) to automatically and efficiently manage personnel planning factors.

Applicants would also like to draw the Examiner's attention to the Manual of Patent Examining Procedure § 2106, part II.A., which states in part (*emphasis added*):

A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. **Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected**

PATENT

under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The Examiner admits that Applicants' "recited process produces a useful, concrete, and tangible result" (see Office Action, page 3, lines 8-10). Therefore, Applicants' claims can not be said to be "devoid of any limitation to a practical application in the technological arts," and should not be rejected under 35 U.S.C. § 101. Applicants respectfully request that the rejections under 35 U.S.C. § 101 be withdrawn.

Claim Rejections - Alleged Anticipation Under 35 U.S.C. § 102

Claims 1-20 stand rejected under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e) as being anticipated by Paizis, U.S. Patent No. 6,338,042 (hereinafter Paizis). Applicants respectfully traverse the rejections under 35 U.S.C. § 102.

To anticipate a claim, the reference must teach every element of the claim (see MPEP § 2131). Applicants respectfully submit that Paizis does not teach every element of claims 1-20. Paizis purports to teach a method and apparatus for incorporating competency and contribution measures into pay decisions (see Abstract). Applicants teach and claim a computer-implemented method, an information handling system, and a computer program product for managing personnel planning factors. Using independent claim 1 as an exemplary claim, Applicants teach and claim the following:

- receiving, over a computer network, planning factor data from a user, the planning factor data

Docket No. AUS920010233US1

Page 12 of 15

Atty Ref. No. 1027

Calderaro, et. al. - 09/895,893

PATENT

corresponding to one or more employees and the planning factor data including risk planning data corresponding to a risk of at least one of the employees leaving an organization;

- storing the planning factor data in employee profile data areas in an employee database, wherein each employee profile data area in the employee database corresponds to one of the employees;
- storing actual employment data for each of the employees in the employee profile data areas in the employee database;
- analyzing the planning factor data; and
- copying one or more planning factors from at least one of the employee profile data areas to the actual employment data corresponding to the employee profile data areas.

Applicants respectfully submit that Paizis does not teach, or even suggest, several elements of Applicants' independent claims. In particular, Paizis does not teach or suggest "receiving, over a computer network, planning factor data from a user, the planning factor data corresponding to one or more employees and **the planning factor data including risk planning data corresponding to a risk of at least one of the employees leaving an organization,**" as taught and claimed by Applicants. As noted by the Examiner, Paizis discusses calculating a target pay for each ranked employee, based on rankings and an external market distribution (col. 6, lines 50-67). Indeed, the entire focus of Paizis is on evaluating employees and determining salaries based on employee evaluations. A careful reading of Paizis does not reveal any discussion or disclosure of risk

PATENT

planning, or any use of planning factor data that includes risk planning data, as taught and claimed by Applicants.

In contrast to Paizis, Applicants teach and claim an employee profile that includes actual employee data, along with planning factor data, such as risk planning data, compensation planning data, stock planning data, development planning data, retention planning data, etc. (see Applicants' specification on page 24, lines 13-20). Risk planning data includes data that indicates the likelihood of an employee leaving the organization (see Applicants' specification on page 28, lines 5-13). Paizis does not address any type of risk planning and therefore does not teach, or even suggest, planning factor data that includes risk planning data corresponding to a risk of at least one of the employees leaving an organization, as taught and claimed by Applicants in amended, independent claims 1, 8, and 14.

Because Paizis does not teach planning factor data that includes risk planning data, Paizis can not possibly teach or suggest "storing the planning factor data in employee profile data areas in an employee database," "analyzing the planning factor data," or "copying one or more planning factors from at least one of the employee profile data areas to the actual employment data," as taught and claimed by Applicants.

For the reasons set forth above, Applicants respectfully submit that independent claims 1, 8, and 14, and the claims which depend from them, are not anticipated by Paizis, and respectfully request that claims 1-20 be allowed.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition

PATENT

for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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Docket No. AUS920010233US1

Page 15 of 15

Atty Ref. No. 1027

Calderaro, et. al. - 09/895,893